



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/918,944	08/25/97	SAWYER	099302

024510 QM21/0910
PIPER MARBURY RUDNICK & WOLFE LLP
STEVEN B KELBER
1200 NINETEENTH STREET, NW
WASHINGTON DC 20036-2412

EXAMINER
SAGER, M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/918,944 08/25/97 SAWYER

T 099302

EXAMINER

QM22/0823

WILBURN L. CHESSER, ESQ.
JONES JAIN, LLP
1110 VERMONT AVENUE, NW SUITE 1150
WASHINGTON DC 20005

SAGER, M

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

08/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/918,944

Applicant(s)
Sawyer et al

Examiner
Sager

Art Unit
3713



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 8, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-55, 59-71, and 74-95 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-55, 59-71, and 74-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

MARK SAGER
PRIMARY EXAMINER

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "42" has been used to designate both railing (20:32, fig. 1) and player input button (fig. 3) which is believed it should be designated --48-- in fig. 3. Correction is required.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second means/device for causing display to reset (clm 48, 50, 52, 54, 68) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is *required*: the language 'independently causes the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points' (clm 95) is not provided support for an automatic/independent function.
4. The amendment filed June 8, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: 'independently causes the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points' (clm 95) is not provided support for an automatic/independent controller function not disclosed or taught in originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

5. Claim 95 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to enable 'independently causes the display to reset for each player in response to the number of bonus points received by each player reaching the predetermined number of bonus points' (clm 95) is not provided support in originally filed disclosure.

Claim Rejections - 35 USC § 103

6. Claims 68-71, 74-78 and 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game in Applicant's background disclosure. This holding for cited claims is maintained from prior action and is incorporated herein. Response to Applicant's assertions of patentability are provided below and incorporated herein.

7. Claims 54-55, 59-65 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game disclosed in Applicant's background disclosure as applied to claims 68-71, 74-78 and 94-95 above, and further in view of Adams (5848932). This holding for cited claims is maintained from prior action and is incorporated herein. Response to Applicant's arguments are provided below and incorporated herein.

8. Claims 48-53, 66 and 75-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game disclosed in Applicant's background

disclosure as applied to claims 68-71, 74 and 94 above, and further in view of Adams (5848932) as applied to claims 54-65 and 67 above, and further in view of Pickardt (GB 2201821A). This holding for cited claims is maintained from prior action and is incorporated herein. Response to Applicant's assertions of patentability are provided below and incorporated herein.

Response to Amendment

9. The declaration under 37 CFR 1.132 filed June 8, 2001 is sufficient to overcome the issue of prior use or sale of claimed electronic controller display used with Trademarked auxiliary game.

Response to Arguments

10. Applicant's arguments filed June 8, 2001 have been fully considered but they are not persuasive. It is noted that filed response appears to have entered new matter (*supra*).

Applicant's failed to seasonably traverse examiner's well known statements in their response, therefore, the object of the examiner's statements (e.g. to provide help or instruction information based upon context or game/application state to aid user, to provide a plurality of games to better attract players since having a larger selection increases the opportunity a player will find a game to their liking and stay to play, to use electronic counters and display devices for tracking and displaying counts electronically to ease record keeping duties so as to reduce counting errors) is each taken as admitted prior art. *In re Chevenard*, 139 F.2d 711, 60 USPQ 239 (CCPA 1943).

Claims 48-51, 54-55, 59-71 and 74-94 are apparatus/device for playing an auxiliary game which increments a counter for a game event observed and manually controlled/incremented by a

casino employee. Claims 52-53 are manual steps requiring human control/activation to a controller to control observed game events. In all pending claims 48-55, 59-71 and 74-94, there is a human operator controlling the auxiliary game/device and activating the device to either by a casino operator to register the game event so as to successively count the successive events to a predetermined goal for an award or by a player to select a random award upon reaching goal such that there is no software or sensing devices which automatically detect so as to register game state (counting game events or selecting award automatically). Further, there is no means to sense or determine whom is operating the device, but is deemed that the whom is operating is determined manually by casino employee observation (this is noting there is no device or means which automatically determines/verifies correct person(s) are operating device for a particular input). Forte's system registers game events upon a casino employee observing and activating game event button inputs, such as lockout, count and reset for game events in an auxiliary card game which improves accuracy of accounting of the game events by reducing counting errors over manual counting without electronic counters while offering smaller more frequent jackpots which will better hold the player's desire to continue playing. The casino operator determines when to input a game event input based upon observing game play in the auxiliary game. In manual play of both primary and auxiliary game, the dealer/casino operator must be aware of game rules of each game and must track game events of auxiliary game in conjunction with monitoring game play of primary game. By using electronic counters, errors in counting of events are reduced in Forte's system or method due to the electronic counters maintaining/incrementing or resetting players counts in accordance with particular auxiliary game played as operated by casino dealer.

Additionally, the admitted prior art Ten Stix 21 game is a manually played auxiliary game operated by a casino employee involving counting predetermined game events to an established goal for an award to maintain player interest which increases casino profits by keeping the player playing longer with admitted disadvantage of poor accounting of game events. It is maintained that the combination of Ten Stix 21 game to Forte's system and method to add an alternative game which increases player interest for the added game while improving accounting of game events by reducing counting errors or to add Forte's system and method to Ten Stix 21 game to improve accounting of game events by reducing counting errors renders claimed features/steps unpatentable. The manually electronic operated table for registering successive game events taught by Forte's system and method and admitted prior art Ten Stix 21 auxiliary game when taken as a whole suggests to an artisan prior to applicant's invention, a device/apparatus or method for improving the accounting of the auxiliary game events in Ten Stix 21 comprising claimed features. In addition, it is well known to utilize technology to automate a previously manual task/function. Forte's table system and method is analogous art demonstrating automation of manual counting functions by using a controller, input devices and displays to record/display game events electronically so as to improve accounting by reducing counting errors inclusive of preventing improper play (supra). Therefore, it would have been obvious to an artisan to automate the accounting functions using a controller, input devices and displays in a table game as suggested by Forte's system and method in admitted prior art Ten Stix 21 auxiliary game to improve counting of game events by reducing counting errors where the auxiliary game offers smaller more frequent jackpots to *better hold the player's desire to continue playing the game*

and makes the conventional blackjack game more exciting (Forte, 2:32-42; 10:5-29) or to provide *incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game* since the players have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicants' background disclosure, 3:12-17; 4:30-5:9). *In re Venner*, 120 USPQ 192 (CCPA 1958). *In re Rundell*, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220. The combination further in view of Adams (or further in view of Pickardt) for randomizing the award renders claimed invention unpatentable for heightened level of anticipation and excitement as they observe an approaching winning position.

Regarding Applicants' response for claims 68-71, 74-78 and 94-95 that prior art does not disclose or suggest the claimed controller 'maintains a number of bonus points received by each of the players when the input device indicates that no new bonus points is to be awarded', the examiner disagrees. Forte's system and method (2:25-42; 3:41-15:48, figs. 1-20) includes a controller (40) that is manually controlled by a casino dealer and thus activations to register accumulated bonus points are based upon casino dealer observations of game play in the auxiliary game and their pressing of associated player key (26) to register/maintain count of points during game play so as to improve accounting of game bonus points by reducing counting errors. Forte's controller maintains display of counts during game play and prevents improper play (figs. 1-20). Further, Applicant's admitted prior art Ten Stix 21 auxiliary game teaches step of play to maintain number of points when no new points are awarded in the auxiliary game (3:3-6:31) since the awarded lammers inherently display number of points awarded and the player maintain this

display during play when no new points are awarded by auxiliary game rules. The dealer controlled activation of observed game events in auxiliary game of Forte's system and method maintains counts of game events based upon dealer input; while, admitted prior art Ten Stix 21 auxiliary game requires maintaining a display of number of bonus points when no new points is to be awarded. Thus, Forte's system and method of electronically controlling a controller, input devices and displays and admitted prior art Ten Stix 21 auxiliary game when taken as a whole suggests to an artisan at time prior to Applicant's invention, a system and method for playing an auxiliary game comprising claimed features/steps of play including a controller electronically recording game progression that 'maintains a number of bonus points received by each of the players when the input device indicates that no new bonus points is to be awarded' by dealer not incrementing or resetting the controller based upon Ten Stix 21 auxiliary game rules of play for easing record keeping requirements of the game for the dealer so as to reduce counting error where the auxiliary game offers smaller more frequent jackpots to *better hold the player's desire to continue playing the game* and makes the conventional blackjack game more exciting (Forte, 2:32-42; 10:5-29) or to provide *incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game* since the players have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicants' background disclosure, 3:12-17; 4:30-5:9).

Further regarding Applicant's remark for claims 68-71, 74-78 and 94-95 that prior art does not disclose or suggest step/feature 'removes any opportunity for players to illegally use bonus incentives provided by auxiliary game', this feature/step is *not* currently claimed for cited

claims. However, in arguendo, Applicant's background states the admitted prior art Ten Stix 21 Game includes preventing improper transfer of bonus points between players by casino personnel as observers and as a game rule (4:23-5:1 and 18-22), but does not include a 'device' performing the prevention capability for the casino. Forte's game and method discloses a device that counts bonus points electronically, provides no physical or tangible counter associated with respective electronically displayed bonus points to a player and thus inherently prevents improper transfer of bonus points between players due to there being no physical object to transfer (figs. 1-20). Additionally, Forte's controller resets the display of counts when a player leaves the game by end of hand device thereby preventing transfer of bonus points between players (4:45-15:48, figs. 1-20). Further, the registering of bonus points is controlled by a dealer's input without any player input (3:41-52; 6:7-13, figs. 1-20). Therefore, Forte in combination with Ten Stix 21 Game suggests to an artisan of gaming, a device/apparatus and method with a controller controlling counters and displays which includes a 'device prevents unauthorized transfer of the accumulated bonus points to and from each player' due to the dealer controlling the electronic registering of bonus points without physical or tangible counters and without any player input thereby improving the accounting of the game by reducing counting error and to provide an alternative auxiliary game so as to increase the likelihood a player will be attracted to play or to play longer (supra).

Regarding Applicants' remark for claims 54-55, 59-65 and 67 that Forte, prior art game Ten Stix 21, and Adams, does not disclose or suggest the claimed device including a 'plurality of manipulable interface units', the claimed device is not limited to only a single 'device' and thus in

a casino environment containing a plurality of table game devices offering auxiliary games as suggested by Forte combined with admitted prior art Ten Stix 21 auxiliary game and further in view of Adams includes at least a device (plurality of tables) including a plurality of manipulable player interface units thereon. Further, Forte discloses a plurality of manipulable player interface units (figs. 1-20) while, Adams teaches/suggests a player interface unit is manipulated by the associated player to select the prize (2:1-9, 30-36; 8:22-39) from a switch within player reach for added excitement. Thus, the combination Forte with admitted prior art game Ten Stix 21 game further in view of Adams suggests to an artisan a device comprising a plurality of manipulable player interface units within player reach for added excitement rendering claimed invention unpatentable. Further, alternatively, Adams suggests that the switch be within reach of a player at a table game (supra). It is known to duplicate parts with a duplication of functionality to provide increased access such as a plurality of telephone devices (a quad on a stand) on a telephone stand or a plurality of wagering areas and respective card areas each associated with a particular player at a gaming table. Thus, it would have been obvious to provide a plurality of manipulable player interface units such that there would be an association between each player at a particular table to each unit of the plurality of manipulable player interface units at each particular table for player convenience so that the switch be within reach of a player for added excitement. Associating a player interface unit with each respective player at a game table so as to provide each player their own associated interface unit is known in gaming for duplicating parts and their functionality for each respective player for player convenience so each player has an interface for game play. *In re Harza*, 124 USPQ 378.

Regarding Applicants' assertion for claims 48-53, 66 and 75-93 that Forte, admitted prior art Ten Stix 21 game, Adams and Pickardt does not disclose or suggest the claimed manipulable interface unit that can be manipulated by the associated player to select a prize, see response to claims 54-65 and 67 incorporated herein. Additionally regarding statement that claim 66 is patentable due to depending from claim 54 (deemed patentable by Applicant), see response to claim 54 incorporated herein.

In response to Applicants statement that a prima facie case of obviousness has not been established, the examiner strongly disagrees. The holdings are clear for presenting in accordance with requirements under statute for

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The holdings are maintained as establishing prima facie case of obviousness for cited prior art and admitted prior art (supra). Within each holding, the examiner stated the scope and content of Forte, admitted prior art, Adams and Pickardt (as applicable to holding), stating the differences as to what the art lacked, the level of ordinary skill in the pertinent art being evidenced from the art of record with motivation from the art or known in the art as admitted prior art for suggesting combination. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 58 CCPA 1310, 443, F.2d 1392, 170 USPQ 209. A reference is to be considered not only for what it expressly states, but also for what it would

reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 56 CCPA 1319, 406 F.2d 1386, 867 OG 722, 160 USPQ 807. The test of obviousness under 35 USC 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest. *In re Conrad*, 169 USPQ 170. In determining the question of obviousness, it is not only the express teachings of the references which are to be considered, but what they would collectively have suggested to one of ordinary skill in the art. *In re Simon*, 59 CCPA 1140, 461 F.2d 1387, 174 USPQ 114. In this instance, the prior art of Forte, admitted prior art Ten Stix 21 auxiliary game, Adams and Pickardt (as applicable) when taken as a whole suggests to an artisan at the time prior to the invention, a system and method containing a controller, input devices and displays for electronically registering bonus points of game events to improve accounting game by reducing counting error and to attract players to play longer and further containing random prizes selected by player input for increased player excitement (*supra*).

Examiner's response in prior action is incorporated herein to the extent that it remains pertinent to Applicant's invention and Applicant's arguments filed June 8, 2001 for the claimed invention being unpatentable over the art.

Finally, remark that Examiner's alternative argument fails since it does not address problems of providing a game with disclosed auxiliary game for preventing improper play by players, it is again noted that the prevention feature is only present in claims 48-49. Response above regarding for claims 68-71, 74-78 and 94-95 and preventing improper play is incorporated herein for all pending claims. Additionally, asserting patentability on an admitted prior art auxiliary game play feature is not persuasive.

The combination of Forte and Ten Stix 21 (and other art in holdings herein) render claimed invention unpatentable.


11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager

Primary Examiner
Aug. 21, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.